

**REMARKS**

**I. Status of the Claims**

Claims 80-186 are pending in this application. Claims 80, 82, 84-149 and 167-186 stand rejected. Claims 81, 83 and 150-166 are withdrawn from consideration. No claim has been amended herein.

**II. Rejections under 35 U.S.C. § 112, Second paragraph**

Claims 80, 82, 84-149 and 167-186 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. See Office Action at 3. The Examiner states that the phrases "less than about" and "greater than about," particularly in claims 102 and 175, are unclear as to their intended values. See *id.* Contrary to the Examiner's assertions, claims 102, and 175 do not recite the term "about," nor do any other of the claims. Rather, the claims, as submitted in Applicants' November 5, 2007, Amendment, recite "less than or equal to" and "greater than or equal to." One of skill in the art could easily determine the scope of this claim language. Thus, the claims at issue are not indefinite. As such, Applicants respectfully request withdrawal of this rejection.

**III. Rejections under 35 U.S.C. § 103(a)**

Claims 80, 84-117, 124-130, 140-149, 175-176, and 178-186 are rejected under 35 U.S.C § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,843,417 to Hanna et al. ("Hanna") in view of U.S. Patent No. 4,552,753 to Elm et al. ("Elm"). See

Office Action at 4-7. The Examiner alleges that Hanna discloses a water-in-oil emulsion comprising a water phase and an oil phase, and further containing a particle, surfactant, polymer, and other ingredients that are common to cosmetic compositions. *See id.* at 5. However, the Examiner states that "Hanna et al. do not teach the claimed concentration of the ingredients, the viscosity of the composition and the specific volatile silicone oils as claimed by applicant." *See id.* at 6. In view of these deficiencies, the Examiner relies upon the teachings of Elm for its disclosure of specific cyclic and linear volatile silicone oils that are "common for use in cosmetics." *Id.* Therefore, the Examiner alleges that "[i]t is within the ability of one of ordinary skill in the art to adjust the viscosity and concentration of the ingredients" to arrive at the desired formulation, and "it would have been obvious to one of ordinary skill in the art to look to the teachings of Elm et al. for examples of linear and cyclic volatile silicone oils that are commonly used in cosmetics [and] . . . one would expect a reasonable chance of success as Hanna et al. broadly describe [silicone oils]. . . . *Id.* Applicants respectfully disagree and traverse this rejection for the following reasons.

In making a rejection under 35 U.S.C. § 103, the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *See* M.P.E.P. § 2142. In its decision in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q. 2d 1385 (2007), the Supreme Court confirmed that the "framework for applying the statutory language of §103" was still based on its landmark decision in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). Under *Graham*, there are four factors for consideration when determining whether an invention is obvious:

- (1) the scope and content of the prior art;
- (2) the differences between the prior art and the claims at issue;
- (3) the level of ordinary skill in the art; and
- (4) secondary considerations.

383 U.S. at 17, 148 U.S.P.Q. at 467. However, the Court indicated that there is no necessary inconsistency between the idea underlying the teaching, suggestion, or motivation ("TSM") test and the *Graham* analysis. *KSR*, 127 S. Ct. at 1741, 82 U.S.P.Q. 2d at 1389. As long as the TSM test is not applied as a "rigid and mandatory" formula, the test can provide "helpful insight" to an obviousness inquiry. *Id.*

Notably, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. §2143.01(III) (emphasis added; citation omitted). Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." M.P.E.P. § 2141.02(I) (emphasis in original; citations omitted).

In the present case, the Examiner admits that Hanna does not teach a composition comprising the ingredients, viscosity, or specific volatile silicone oils as claimed, *see Office Action* at 6; however, contrary to the Examiner's assertions, Elm does not remedy the deficiency. Elm teaches a process for making roll-on antiperspirant compositions, comprising volatile silicone oils, non-volatile silicone oils, an antiperspirant active, and a bulking/suspending material. *See* col 2, lines 7-15. In

particular, the compositions of Elm are not oil/water emulsions, and Elm makes no reference to the compositions having fluid-like properties. In addition, Elm references a plurality of oils that may be useful for cosmetics, but only provides examples of silicone oils that are useful for roll-on antiperspirant compositions. See col. 2-3, lines 59-45. Hanna, on the other hand, teaches cosmetic products in a water-in-oil emulsion, where the oil is principally based upon C<sub>10</sub>-C<sub>14</sub> linear or branched hydrocarbons. See col. 1, lines 5-10. Furthermore, Hanna teaches that the absence of silicone oils in the invention is preferred. See col. 3, lines 43-44.

Thus, Elm and Hanna are directed to compositions having different forms: Elm's compositions have silicone oils but not in oil/water emulsions; Hanna's compositions are oil/water emulsions where hydrocarbon oils are preferred. To one of ordinary skill, nothing in Elm suggests using the silicone oils taught therein in the hydrocarbon, oil-in-water compositions taught by Hanna, much less suggests further adjusting the concentration and viscosity ranges of Elm's silicone oils to arrive at the claimed composition. In fact, Hanna's limited teaching of silicone oils suggests the use of silicone oils "commonly used in W/O cosmetic emulsions," col. 3, lines 33-35, which is not the case in Elm.

Moreover, contrary to the Examiner's assertion, arriving at the claimed ratios is not a matter of routine experimentation, i.e., merely adjusting individual concentrations and/or viscosity. Rather, it requires manipulation of a ratio, which depends on modification of numerous variables, provided one of skill in the art even knew to consider the ration, which Applicants do not concede.

Additionally, the skilled artisan would have no reasonable expectation of success in combining the references in the manner asserted by the Examiner, particularly in view of Hanna's teaching that the preferred embodiment lacks silicone oils and Elm's teaching that it was known in the art that compositions containing volatile and nonvolatile silicones are subject to "compositional instability," col. 1, lines 34-36.

Thus, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, Applicants respectfully request withdrawal of this rejection.

#### **IV. Double Patenting Rejection**

Claims 80, 82, 84-149 and 167-186 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12, 15 and 18-99 of copending U.S. Application No. 10/603,698 for the reasons set forth at pages 3-4 of the Office Action. Applicants respectfully request that the Examiner hold this rejection in abeyance until there is an indication of allowable subject matter.

#### **V. Conclusion**

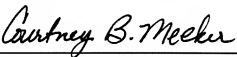
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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